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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,148	04/15/2004	Klaus Schippl	979-062	8759

7590 09/25/2006  
SOFER & HAROUN, L.L.P.  
317 Madison Avenue, Suite 910  
New York, NY 10017

EXAMINER

NGUYEN, DONGHAI D

ART UNIT PAPER NUMBER

3729

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/826,148	SCHIPPL, KLAUS	
	<b>Examiner</b>	<b>Art Unit</b>	
	Donghai D. Nguyen	3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed on May 18, 2006 has been considered and made of record.

***Specification***

2. The abstract of the disclosure should be modified to read on the method invention without repeating the claims and the abstract must not exceed 150 words in length. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation of: "or is lying in at least one turn" (claim 5 lines 19-20) is vague and confusing because it is not know how the cable being lay in at least one turn and whether the cable is lying on the cable drum in at least one turn or coiled up in at least one turn.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,718,618 to Hirose et al in view of Japanese Patent (publication number 09-134,624) to Shibata et al.

Regarding claims 5 and 8, Hirose et al et al disclose a process for the production of a superconducting cable having a cable core, which contains at least one elongated superconducting element, and a flexible tube, which surrounds the cable core, said process comprising the steps of: continuously pulling the cable core (with high temperature superconductor 6 see Fig. 1) from a supply unit (see Fig. 2); (b) continuously pulling a metal strip (20) from a strip supply unit (see Fig. 4); (c) continuously forming a slotted tube around the cable core with the metal strip to form a slotted tube (see Fig. 4); welding a the longitudinal slot of the slotted tube is-welded shut (by welder 21); corrugating the welded tube with the cable core inside the tube, where the inside diameter of the corrugated tube is larger than the outside diameter of the cable core to form a semi-finished superconducting cable (see Fig. 4); (d) winding the semi-finished superconducting cable on a drum (23). Hirose et al is silent regarding mechanically joining the ends of single cable core to the ends of the tube while the cable is on the cable drum or is lying in at least one turn. Shibata et al teach the mechanically joining the ends of single cable core (1) to the ends of the tube (2 with a cap) while the cable is on the cable drum (24 and see Computer translated paragraph 0009) or is lying in at least one turn for keeping the single core in snake configuration inside the tube (see Fig. 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the

invention of Hirose et al by utilize the mechanically joining the ends of single cable core to the ends of the tube while the cable is on the cable drum as taught by Shibata et al for obtaining a superconductor having the single core in snake configuration inside the tube.

Regarding claims 6 and 7, Hirose et al teach the slack or the exceed length of the core cable being configuration base on its lengths (see Col. 4, lines 31-40). Regarding the configuration of 0.25%, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have configured the forming cable core into the tube in such a way such that the exceed length is being at least 0.25% of its original length.

#### *Response to Arguments*

7. Applicant's arguments with respect to claims 5-8 have been considered but are moot in view of the new ground(s) of rejection.

#### *Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (571)-272-4566. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571)-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DN

September 18, 2006

  
MINH TRINH  
PRIMARY EXAMINER